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| 09/808,815 | 03/14/2001 | Khoo Soon Huat | 400.04 | 6334 |

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| 7590 07/01/2004 | **EXAMINER** | |
| Todd A. Noah | MAURO JR, THOMAS J | |
| Dergosits & Noah LLP | | |
| Suite 1150 | **ART UNIT** | **PAPER NUMBER** |
| Four Embarcadero Center | 2143 | |
| San Francisco, CA 94111 | | |

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>*14 March 2001*</u>.
2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-5 and 7-20* is/are rejected.
7)☒ Claim(s) *6* is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>*14 March 2001*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
            application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

## DETAILED ACTION

1.      Claims 1-20 are pending and are presented for examination.  A formal action on the

merits of claims 1-20 follows.


### *Claim Objections*

2.      Claim 3 is objected to because of the following informalities:  claim 3 depends on claim

4, however Examiner has interpreted this as a typo and, for the purposes of examination, has

interpreted claim 3 depending from claim 2.  Appropriate correction is required.


### *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.      Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Markowitz et al.

(U.S. 6,311,185).


        With respect to claim 16, Markowitz teaches a system for displaying an intermediate

message to a plurality comprising:

a server computer hosting a message service **[Markowitz -- Figure 1 and Col. 2 lines 65-67 – Server holds database containing advertisements]**;

a plurality of client computers each running browser programs and each having a visual display projecting a graphic user interface (GUI) of the browser program and an input device which can control at least some functions of the browser programs **[Markowitz -- Figure 1 and Col. 2 lines 57-64 – Client computer (although only one is shown, it is obvious a plurality of client computers can exist) has a browser program, i.e. GUI, which obviously receives requests for information via a user input device, obvious to all computers]**;

a computer network providing a communication link between the server computer and the plurality of client computers **[Markowitz -- Figure 1 and Col. 3 lines 60-65 – Internet is computer network linking client and server]**; and

a database in communication with the network for storing intermediate messages **[Markowitz -- Figure 1 and Col. 1 lines 65-67 – Col. 2 lines 1-18]**;

wherein the server computer provides the intermediate message to each of the plurality of client computers and wherein the intermediate message is displayed in an unused area of the active display space of the browser programs **[Markowitz -- Figure 4, Col. 3 lines 19-29 and Col. 4 lines 1-6 and lines 20-29 – Server executes a process to determine blank areas on a particular web page so that advertisement information can be displayed]**.

## *Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.      Claims 1, 7-10, 14-15, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Markowitz et al. (U.S. 6,311,185) in view of Bates et al. (U.S. 5,390,295).


Regarding claim 1, Markowitz teaches a method of displaying an intermediate message

in a web browser executed on a client computer, comprising the steps of:

identifying an active display window of the web browser **[Markowitz -- Figure 4 and

Col. 4 lines 20-29 – Active display window is the browser window viewing the current

webpage]**;

identifying an unused display space within the active display window; and

displaying the intermediate message in the message display window **[Markowitz -- Col.

3 lines 19-29 and Col. 4 lines 1-4 and lines 20-29 – Web page modifier engine examines page

to determine unused space on page without any text, graphics, images, etc. Once unused

space is determined, advertisement is displayed in those areas]**.

Markowitz, while not explicitly teaching defining size and dimensions of an intermediate

message along with the size and dimensions of the unused area, does point out that size is taken

into consideration when deciding where to place an advertisement and how it can be best added

**[Markowitz -- Col. 3 lines 19-29 and Col. 4 lines 42-45]**.

Bates, however, explicitly discloses determining the size of region on a display screen and a window to determine if the windows will fit in a given area and if it will be the "best fit" **[Bates -- Col. 6 lines 31-54 and Col. 12 lines 47-67 – Col. 13 lines 1-32]**. Therefore, if windows can be dimensioned to determine their size, it would have been obvious that anything, including message windows and unused regions on a web page could also be measured in order to determine the size for fitting objects into spaces.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the determining of size information of windows/objects and regions on a page, as taught by Bates into the invention of Markowitz, in order to provide for a better, more functional and easier to navigate site which displays all information without hiding or covering other information.

Regarding claim 7, Markowitz-Bates teach the invention substantially as claimed, as aforementioned in claim 1 above, including wherein the intermediate message is an advertising text message generated and provided to the client computer by a third party content provider coupled to the client computer over a computer network **[Markowitz -- Col. 2 lines 57-67 – Col. 3 lines 1-18 – Advertising information, i.e. text, graphics, etc., is provided to a client requesting a webpage through a central server connected to the client via the network (Internet)]**.

Regarding claim 8, Markowitz-Bates teach the invention substantially as claimed, as aforementioned in claim 1 above, including storing the intermediate message in a memory of the

client computer **[Markowitz -- Col. 4 lines 46-54 – Advertising information can be pre-cached, i.e. stored, at the client computer for faster loading]**.

Regarding claim 9, Markowitz-Bates teach the invention substantially as claimed, as aforementioned in claim 1 above, wherein the client compute is coupled to a web server computer over the Internet network **[Markowitz -- Figure 1 and Col. 2 lines 57-64]**, and wherein the client computer executes client processes operable to transmit and receive data files over the World Wide Web portion of the Internet and further wherein the web page data comprises Hypertext Markup Language (HTML) data executable by the client processes **[Markowitz -- Figure 1 and Col. 3 lines 60-67 – Col. 4 lines 1-6 – Client interface, i.e. browser, sends requests for HTML data out across Internet and awaits page to be transferred and displayed in browser]**.

Regarding claim 10, Markowitz teaches a system for displaying an intermediate message to a plurality comprising:

a server computer hosting a message service **[Markowitz -- Figure 1 and Col. 2 lines 65-67 – Server holds database containing advertisements]**;

a plurality of client computers each running browser programs and each having a visual display projecting a graphic user interface (GUI) of the browser program and an input device which can control at least some functions of the browser programs **[Markowitz -- Figure 1 and Col. 2 lines 57-64 – Client computer (although only one is shown, it is obvious a plurality of**

**client computers can exist) has a browser program, i.e. GUI, which obviously receives**

**requests for information via a user input device, obvious to all computers]**;

a computer network providing a communication link between the server computer and

the plurality of client computers **[Markowitz -- Figure 1 and Col. 3 lines 60-65 -- Internet is**

**computer network linking client and server]**; and

a database in communication with the network for storing intermediate messages

**[Markowitz -- Figure 1 and Col. 1 lines 65-67 -- Col. 2 lines 1-18]**;

wherein the client computer executes a process operable to identify empty space in an

active display page, re-identify and capture unused space within the active display page when

page contents and layout change in response to user commands **[Markowitz -- Figure 4, Col. 3**

**lines 19-29 and Col. 4 lines 1-6, lines 20-29 and lines 34-45 -- Server executes a process to**

**determine blank areas on a particular web page so that advertisement information can be**

**displayed. It would be obvious that the web page modifier engine monitors for changes to**

**the current page, i.e. new page is requested, in order to make determinations as to where**

**ads can be placed on this new page]**.

Markowitz, while not explicitly teaching defining size and dimensions of an intermediate

message along with the size and dimensions of the unused area, he does point out that size is

taken into consideration when deciding where to place an advertisement and how it can be best

added **[Markowitz -- Col. 3 lines 19-29 and Col. 4 lines 42-45]**.

Bates, however, explicitly discloses determining the size of region on a display screen and a

window to determine if the windows will fit in a given area and if it will be the "best fit" **[Bates -**

**- Col. 6 lines 31-54 and Col. 12 lines 47-67 -- Col. 13 lines 1-32]**. Therefore, if windows can be

dimensioned to determine their size, it would have been obvious that anything, including

message windows and unused regions on a web page could also be measured in order to

determine the size for fitting objects into spaces.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to incorporate the determining of size information of windows/objects and regions on

a page, as taught by Bates into the invention of Markowitz, in order to provide for a better, more

functional and easier to navigate site which displays all information without hiding or covering

other information.


Regarding claims 14-15, these are system claims corresponding to the method claimed in

claims 7-8.  They have similar limitations; therefore, claims 14-15 are rejected under the same

rationale.


Regarding claim 17, Markowitz teaches the invention substantially as claimed, as

aforementioned in claim 16 above, including determining purposive content displayed in the

active area in response to user commands **[Markowitz -- Figure 4, Col. 3 lines 19-29 and Col.**

**4 lines 1-6 and lines 20-29 – Server executes a process to determine blank areas on a**

**particular web page so that advertisement information can be displayed.  It would be**

**obvious that the web page modifier engine monitors for changes, i.e. user commands, to the**

**current page, i.e. new page is requested, in order to make determinations as to where ads**

**can be placed on this new page]**.

Markowitz fails to explicitly teach wherein the unused area is determined in relation to a size of the message, i.e. advertisement.

Markowitz, while not explicitly teaching defining size and dimensions of an intermediate message along with the size and dimensions of the unused area, he does point out that size is taken into consideration when deciding where to place an advertisement and how it can be best added **[Markowitz -- Col. 3 lines 19-29 and Col. 4 lines 42-45]**.

Bates, however, explicitly discloses determining the size of region on a display screen and a window to determine if the windows will fit in a given area and if it will be the "best fit" **[Bates -- Col. 6 lines 31-54 and Col. 12 lines 47-67 – Col. 13 lines 1-32]**. Therefore, if windows can be dimensioned to determine their size, it would have been obvious that anything, including message windows and unused regions on a web page could also be measured in order to determine the size for fitting objects into spaces.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the determining of size information of windows/objects and regions on a page, as taught by Bates into the invention of Markowitz, in order to provide for a better, more functional and easier to navigate site which displays all information without hiding or covering other information.


Regarding claims 19-20, these are system claims corresponding to the method claimed in claims 7-8. They have similar limitations; therefore, claims 19-20 are rejected under the same rationale.

7.      Claims 2-5, 11-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Markowitz et al. (U.S. 6,311,185) and Bates et al. (U.S. 5,390,295), as applied to claims 1, 10

and 17 above respectively, in view of Aleksic (U.S. 6,084,591).

Regarding claim 2, Markowitz-Bates teach the invention substantially as claimed, as

aforementioned in claim 1 above, but fails to explicitly teach defining a background pattern and

comparing blocks of pixels within the active display window to the defined background pattern.

Aleksic, however, discloses a system rendering pixel information on a display which compares

object elements to the background pattern to determine the position or change of an object, i.e. a

triangle **[Aleksic -- Col. 4 lines 24-46, Col. 5 lines 22-40 and Col. 6 lines 55-67]**.

Markowitz-Bates teach a method of determining unused space on a webpage which requires a

method like that of Aleksic.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to incorporate the comparing of pixels within a display to a defined background

pattern, as taught by Aleksic into the invention of Markowitz-Bates, in order to provide an

efficient and accurate method to determine patterns on a webpage to distinguish between objects

and blank space.

Regarding claim 3, Markowitz-Bates-Aleksic teach the invention substantially as

claimed, as aforementioned in claim 2 above, including wherein the pattern comprises a red-

green-blue (RGB) pixel color pattern **[Aleksic -- Col. 4 lines 1-17 – Background pattern consists of red-blue-green (RGB) color pattern]**.

Regarding claim 4, Markowitz-Bates-Aleksic teach the invention substantially as claimed, as aforementioned in claim 2 above, including monitoring the state of the active display windows to determine if there is a change in content of the active display windows to produce a new active display window **[Markowitz -- Col. 4 lines 20-29 – Current webpage requested is analyzed for unused spaces to place advertisements. Thus it would be obvious that the web page modifier engine monitors for changes to the current display, i.e. new page is requested, in order to make determinations as to where ads can be placed on this new page]**.

Regarding claim 5, Markowitz-Bates-Aleksic teach the invention substantially as claimed, as aforementioned in claim 4 above, including monitoring a period of time that the active display windows is active **[Bates -- Col. 4 lines 64-68 – Col. 5 lines 1-27 – Time period is measured as each window becomes active to determine each window's period of activity]**.

Regarding claims 11, 12 and 13, these are system claims corresponding to the method claimed in claims 3, 2 and 5 respectively. They have similar limitations; therefore, claims 11, 12 and 13 are rejected under the same rationale.

Regarding claim 18, this is a system claims corresponding to the method claimed in claim 2. It has similar limitations; therefore, claim 18 is rejected under the same rationale.

## *Allowable Subject Matter*

8.     Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. All limitations contained in any dependent claim must fully appear in the new independent claim.

## *Conclusion*

9.     The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kraus et al. (U.S. 6,266,684) discloses a system for authoring web pages which has a routine for determining the size of an empty area of a page.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJM
June 24, 2004

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100